

REMARKS

Applicants respectfully traverse the rejection of claims 1-34 under 35 U.S.C. §103(a) over European Patent No. EP 1160708 A1 (“Utsumi”), at page 2, paragraph 3 of the Office Action. Utsumi discloses a server 5 that allows a patent rights holder to enter data, such as an application number, an unexamined publication number, a registration number, the right holder’s name, a technical field, an abstract, and claims of the patent in question, on a server of a server management company 4. *See Utsumi*, p. 3, paragraph 0023 and 0025. Utsumi discloses that the server management company provides part or all of the information about the right in question on a website. *See Utsumi*, p. 4, paragraph 0024 and Figure 2. Utsumi discloses that a reader browsing the website may select portions indicative of the registered rights by use of a mouse. *See Utsumi*, p. 4, paragraph 0027. Utsumi discloses that the server opens an input screen in response to user selections, and a user may enter information about the selected right via the input screen. *See Utsumi*, p. 4, paragraph 0027. Additionally, Utsumi discloses that the screen is made up of three windows: a mail address input window 21, and account number input window 22, and a detailed information input window 23. *See Utsumi*, p. 4, paragraph 0030 and Figure 3.

The Office Action states:

Although Utsumi does not specifically recite “identifying an infringement target”, along with a description of how said target meets the criteria, nevertheless, since window 23 is offered for input of infringement target information, and since the size of the window suggests the capability of inputting as much information as possible, it would have been obvious to one of ordinary skill in the art at the time of the invention to include multiple (i.e. a first and second, etc.) user input comprising at least the identification of “an infringement target”, along with some form of analysis of how the target meets the criteria set forth in the original posting. Doing so provides the benefit of providing as complete and as detailed infringement information as possible, therefore increasing the chances of obtaining a reward.

See Office Action, pp. 2-3, paragraph 4.

Applicants disagree. Utsumi discloses that the information provider may wish only to express willingness to provide information. *See Utsumi*, p. 4, paragraph 0030. The asserted motivation to modify Utsumi to include multiple user inputs is not supported by disclosure of Utsumi. Moreover, even if a user may be motivated to provide such information within the single user input of Utsumi, there exists no motivation to include multiple inputs. The

motivation to modify Utsumi is an impermissible hindsight reconstruction based on the disclosure of the present application. Therefore, the rejection of claims 1-34 is improper and should be withdrawn.

Moreover, Utsumi fails to disclose or suggest posting an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited by independent claim 1. Additionally, Utsumi fails to disclose or suggest a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited by independent claim 24.

Utsumi discloses a first web page that displays patent numbers, technical fields, product fields, filing dates, and claims (*See Utsumi*, pp. 3-4, paragraph 0025) and a second web page that allows for user inputs (*See Utsumi*, p. 4, paragraph 0027). Thus, Utsumi fails to disclose “an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target, as recited by claim 1. Utsumi also fails to disclose or suggest an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target, as recited by claim 24.

Utsumi discloses a single input for entering a posting to the website reporting possession of pertinent information (*See Utsumi*, p. 4, paragraph 0029). Utsumi discloses that the information provider expresses his willingness to providing information in the input window or writes the information itself in the window for transmission to the server management company. *See Utsumi*, p. 4, paragraph 0030. Utsumi fails to disclose or suggest a first user input to identify an infringement target and a second user input to describe how the infringement target meets the criteria, as recited by claims 1 and 24. Moreover, Utsumi fails to disclose or suggest a first user input to identify an infringement target, as recited by claims 1 and 24.

Thus, Utsumi fails to disclose or suggest at least one element of independent claims 1 and 24 and of claims 2-23 and 25-34, at least by virtue of their dependency from claims 1 and 24. Therefore, the rejection of claims 1-34 over Utsumi should be withdrawn.

Additionally, Utsumi fails to disclose or suggest other elements of claims 1-34. For example, with regard to the rejection of claims 2 at page 3 of the Office Action, the plurality of input boxes cited with regard to Figure 3 of Utsumi are in a separate screen from the display screen indicating the infringement criteria. Thus, Utsumi fails to disclose or suggest that the electronic form comprises a plurality of input boxes to accept the second user input, as recited by claim 2.

With regard to the rejection of claims 4-8 at page 3 of the Office Action, the Office Action states:

Since clicking on a link (Utsumi Figure 2 items 13-15) results in the submission window of Figure 3, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply said window adjacent to (i.e. near to, or in columnar fashion etc.) the criteria, providing the benefit of increased organization.

See Office Action, p. 3.

Utsumi fails to disclose or suggest a plurality of display portions each to display a respective one of the criteria, and wherein each of the plurality of input boxes is positioned adjacent to one of the plurality of display portions to receive a portion of the second user input which describes how the infringement target meets the respective one of the criteria, as recited by claim 4. Moreover, Applicants submit that the window of Figure 3 of Utsumi is a separate window from the display portions. Even if the input window of Utsumi were applied adjacent to the criteria as suggested by the Office Action, the input window of Utsumi would still be separate from the criteria window. Therefore, Utsumi fails to disclose or suggest at least one element of each of the claims 4-8.

CONCLUSION

Applicants have pointed out specific features of the claims not disclosed, suggested, or rendered obvious by the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the rejections, as well as an indication of the allowability of each of the pending claims 1-34.

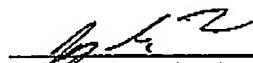
The Examiner is invited to contact the undersigned attorney at the telephone number listed below if such a call would in any way facilitate allowance of this application.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

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Date



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